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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,329	05/25/2000	William M. Randle	0258100-126392	6339

7590 06/04/2003

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Columbus, OH 43215

EXAMINER

SNAPP, SANDRA S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/578,329

Applicant(s)

RANDLE ET AL.

Examiner

Sandra Snapp

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 16,29,31 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15,17-28 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 11 March 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

***Drawings***

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 3-11-3 have been considered and are acceptable.

***Claim Objections***

The claim objections have been successfully overcome with the pending amendment.

***Claim Rejections - 35 USC § 112***

The rejection of claims 9 and 30 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has not been overcome and is therefore made final.

The rejection of claim 9 is maintained because the phrase "mall merchant" is inconsistent with the previous citations of simply a "merchant."

The rejection of claim 30 is maintained because the paragraph from lines 5-7 is still confusing. It appears the network links the employee account custodians, employer account custodians, employees and employers together, however, it is unclear how or if the employee account custodians, employer account custodians and the settlement mechanism are also linked together.

***Claim Rejections - 35 USC § 102***

The rejection of claims 1-15, 17-28 and 30 under 35 U.S.C. 102(b) as being anticipated by the Shavit et al. patent is maintained and herein made final.

The Shavit reference discloses an electronic commerce system that has an association of user account custodians and merchant account custodians (col. 8, lines 55-68); a network (col. 5, lines 20-38) interconnecting the various parties of the system (col. 5, lines 39-65); a vendor mall (col. 5, lines 66-68 and col. 6, lines 1-18); a network switch (col. 6, lines 57-68); a means in the network switch for receiving transaction information (col. 9, lines 43-68); a mechanism to effect a guarantee of good funds in the account (col. 8, lines 55-68 and col. 9, lines 1-68); a control means in the network switch to initiate the settlement mechanism (col. 9, lines 43-68) (claims 1 and 31); an identity screening mechanism (col. 9, line 43 through col. 10, line 44) (claim 3); and a third party intermediary reimbursement service site (col. 8, lines 5-68 and col. 9, lines 1-68) (claim 30).

While claim 30 is directed to the above system having employees and employers, the Examiner takes the point of view that the employee/employer relationship as defined in claim 30 is still one of user/merchant and therefore claim 30 is anticipated by Shavit et al. for the reasons stated above.

***Response to Arguments***

Applicant's arguments filed 3-11-3 have been fully considered but they are not persuasive. The Applicant amended the present claims to identify the users/merchants as "institutional" however this change does not distinguish the present invention from the prior art.

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Shavit identifies that the system is for "various members of an industry" and as such is an "institutional" system as claimed. (col. 2, line 12). Also, the term "subscriber" in Shavit inherently infers the system participants subscribe to a common set of rules.

The Applicant discusses the security benefits of the present system as distinguishing it from the Shavit system, however the Examiner does not agree. The Shavit system discloses a secure system via its screening process as outlined in col.9, line 43 through col. 10, line 44.

For these and the previous cited rationale, the rejections of record are herein maintained and made final.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

SS

June 2, 2003

RICHARD WEISBERGER  
PRIMARY EXAMINER